

App. Serial No. 10/500,064  
Docket No.: DE010359

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Remarks

Claims 1-15 are currently pending in the patent application. Applicant has made amendments to various claims. These amendments are largely intended to incorporate the limitations already found in claims 13 and 14 (*i.e.*, that the claimed invention is directed toward smart cards). For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated February 22, 2007 listed the following: the Specification was objected to because of the lack of section headings, claims 1-12 and 14-15 stand rejected under 35 U.S.C. § 102(b) over Lasker *et al.* (U.S. 5,586,291); and claim 13 stands rejected under 35 U.S.C. § 103(a) over "Non-Volatile Memory: The Principles, the Technologies, and their Significance to the Smart Card Integrated Circuit" by David Sowards in view of Lasker.

Applicant respectfully declines to add section headings to the specification because the indicated suggestions in 37 C.F.R. § 1.77(b) are not statutorily required for filing a non-provisional patent application under 35 USC § 111(a), but per 37 C.F.R. § 1.51(d) are only guidelines that are suggested for applicant's use. They are not mandatory, and when Rule 77 was amended in 1996 (61 FR 42790, Aug. 19, 1996), Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, stated in the Official Gazette:

"Section 1.77 is permissive rather than mandatory. ... 1.77 merely expresses the Office's preference for the arrangement of the application elements. The Office may advise an applicant that the application does not comply with the format set forth in 1.77, and suggest this format for the applicant's consideration; however, the Office will not require any application to comply with the format set forth in 1.77."

In view of the above, Applicant prefers not to add section headings.

Applicant respectfully submits that the Section 102(b) rejections of claims 1-12 and 14-15 cannot stand because the cited portions of the Lasker reference fail to correspond to all of the claimed limitations. For example, the cited portions of the Lasker reference do not correspond to the claimed limitations directed toward writing to the non-volatile memory of a smart card. The Lasker reference is directed to disk storage subsystems and the transfer of data between a host computer and a disk storage subsystem. *See, e.g.*, Col. 3:1-16. Applicant submits that the Lasker reference, which is

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concerned with data backup systems and maintaining data coherency between the various backup memory locations (*i.e.*, memory modules 32 and 34 and disk drives 18), is unrelated to the claimed invention. *See, e.g.*, Figure 1 and Col. 7:16 to Col. 8:12. The cited portions of the Lasker reference do not teach a smart card, let alone using the processor of the smart card to write to the memory of the smart card as in the claimed invention. Accordingly, the Section 102(b) rejection of claims 1-12 and 14-15 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the Section 103(a) rejection of claim 13 because the Lasker reference is not analogous art to the claimed invention. In order for the Office Action to rely upon a reference as the basis for a Section 103 rejection, the reference must be analogous art. *See* M.P.E.P. § 2141.01(a). M.P.E.P. § 2141.01(a)(V) further states that for analogy in the electrical arts

*See, for example, Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories.

As discussed above, the Lasker reference is directed to disk storage subsystems and to maintaining data coherency between data that is stored in multiple different memories. One of skill in the art would recognize that disk storage subsystems are quite large in relation to a smart card, and that such systems often fill entire rooms. As such, Applicant submits that the Lasker reference is non-analogous art to the claimed invention, which involves writing to the non-volatile memory of a smart card.

Moreover, the Office Action alleges that the reason for combining the teachings of the Lasker reference with a smart card taught by Sowards would be to allow "the non-volatile memory to be made rapidly available and increase efficiency (column 5, lines 37-41)." *See*, the instant Office Action on page 9. However, the Lasker reference teaches that the data is stored on the disk drives, which allows the non-volatile memory where the data is being stored to be made available for use in other write operations. *See, e.g.*, Col. 3:35-39. Thus, the Office Action appears to be proposing modifying a smart card to

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include a disk drive and transferring the data in the memory of the smart card to the disk drive. Applicant submits that such a combination would no longer be a smart card and would in no way correspond to the claimed invention. Should the rejection be maintained, Applicant respectfully requests clarification regarding how the Office Action is proposing to modify the smart card taught by Sowards, and an opportunity to respond thereto. In view of the above, the Section 103(a) rejection of claim 13 is improper and Applicant requests that it be withdrawn. In view of the above discussion, Applicant also submits that such a combination would be improper for the amended claims, which are also directed toward smart cards.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

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